

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

06/771,555 01/03/01 HODGSON

P 53186

HM12/0918

HERBERT B. KEIL
KEIL & WEINKAUF
1101 CONNECTICUT AVE., N.W.
WASHINGTON DC 20036

EXAMINER

CLASS	ART UNIT	PAPER NUMBER
-------	----------	--------------

1616

DATE MAILED:

09/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/771,595	HOSSEL ET AL.
	Examiner Marina Lamm	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 - 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 7-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claims 1-16 are pending in this application filed 1/30/01. Claims 1-5 and 7-16 are readable upon the elected species. Claim 6 is withdrawn from further consideration as directed to non-elected species.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 9, 10 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "wherein the monomer (e) used is 0.01 to 10% by weight of least one monomer ... which acts as crosslinker." The quoted phrase is confusing. Clarification is required.

Claim 9 recites the limitation "at least one hydrophobicized metal oxide" in line 2. There is insufficient antecedent basis for this limitation in the claim because Claim 8 recites "micronized metal oxide".

Claims 13 and 14 are viewed as indefinite because the applicant has failed to recite the specific positive method steps and limitations which contribute to the claimed process for the

Art Unit: 1616

preparation of cosmetic and dermatological preparations. A method should at least recite positive, active steps and any method parameters necessitated by the specification so that the claims will "clearly set out and circumscribe a particular area with a reasonable degree of precision and particularity", In re Moore, 169 USPQ 236, " and make it clear what subject matter from others would be precluded". In re Hammack, 166, USPQ 204. The above stated claims merely recite that "a mixture defined as in claim 1 is prepared". Further, Claims 13 and 14 are viewed as indefinite because they recite applying the composition to the human skin or the human hair. This recitation is confusing because the preamble of the claims is directed to the process of making the cosmetic compositions and not the process of using them.

Claim 16 is viewed as indefinite because it recites 3-methyl-1-vinylimidazolium methosulfate as monomer (a) and it also recites the limitation "(a) is not quaternized or only partially quaternized." It appears that 3-methyl-1-vinylimidazolium methosulfate is a *quaternized* form of 3-methyl-1-vinylimidazole. Clarification is required in this matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 and 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieing et al. (EP 893117) in combination with either Matsumoto et al. (US 5,603,926) or Tanner et al. (US 5,827,508).

Dieing et al. teach cationic crosslinked polymers for use in hair care compositions, said polymers comprising 1-99.99% of a cationic or quaternized monomer such as 3-methyl-1-vinylimidazolium methyl sulfate and 0-98.99% of a water-soluble monomer such as N-vinylpyrrolidone. See EP 893117 at p. 4, lines 20-25 and English Abstract. N,N'-divinylethylenurea can be used as a crosslinking agent. See EP 893117 at p. 5, line 29, p. 7, Example 3 and English Abstract. The polymers of Dieing et al. are obtained by the same method of free-radical initiated solution polymerization as recited in the instant claims. See EP 893117 at p.5. The polymers of Dieing et al. "when added to shampoos, show excellent conditioning properties without a build-up effect.". See English Abstract.

Matsumoto et al. teach hair cosmetic compositions comprising cationic polymers in combination with zinc oxide treated with silicone and titanium oxide treated with silicone (Example 51). Tanner et al. teach that it is conventional to employ sunscreen agents in a variety of personal care products. See col. 1, lines 51-53.

Tanner et al. teach using a surface treated zinc oxide in combination with a dibenzoylmethane sunscreen compound in cosmetic compositions for providing excellent photostability, chemical stability and physical stability of the cosmetic compositions as well as good UVA protection. See col. 2, lines 18-22; col. 7, lines 17-34; col. 8, lines 49-54. The compositions of Tanner et al. may contain crosslinked cationic polymers. See col. 10-12.

One of ordinary skill would have been motivated to employ sunscreens of either Matsumoto et al. or Tanner et al. for hair care compositions of Dieing et al. for their art-recognized purpose and with a reasonable expectation of beneficial results such as improved

Art Unit: 1616

photostability, chemical stability and physical stability of the compositions as well as good UVA protection.

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use cationic polymers of Dieing et al. in cosmetic composition of either Matsumoto et al. or Tanner et al. for their art-recognized purpose and with a reasonable expectation of beneficial results such as improved conditioning properties of the compositions.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

6. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml
9/14/01

JESSIE DEES
SUPERVISORY PATENT EXAMINER

1616